

REMARKS

Claims 24-29 and 31-38 are pending in the application with claims 24, 25, 29, 32 and 37 being independent claims. Applicants respectfully request reconsideration of the Application in light of the above amendment and the following remarks.

Interview Request

In a telephone conversation with Examiner Lev on January 24, 2005, Applicants' representative requested an interview to discuss potential amendments that would place the application in condition for allowance. Examiner Lev suggested that Applicants' representative submit a response in writing and request a telephonic interview as part of the response. Accordingly, Applicants respectfully request that the Examiner contact the undersigned to conduct a telephonic interview prior to issuing any further action with respect to this application to the extent any outstanding issues remain in light of this response.

New Matter Objection

The amendment filed on September 23, 2004 stands objected to under 35 U.S.C. § 132 because it introduces new matter into the disclosure. The Examiner states that the term "a second frame" is not discussed in the specification or shown in the drawings. Applicants respectfully disagree. A second frame is expressly disclosed, for example, at paragraph [0071] on page 16. The shade 10 is disclosed as being "proximate to but distanced from the towel 100 . . . In one embodiment, towel 100 can include a frame member mounted in a membrane." Additionally, Applicants claim priority to and incorporate by reference U.S. Patent Application Serial No. 09/229,968, which discloses such a configuration (see, e.g., paragraph [0001] and [0053]). Accordingly, Applicants respectfully request that the objection be withdrawn.

Double Patenting Rejection

Claims 24-29 and 31-38 stand rejected under the judicially created doctrine of obviousness-type double patenting over the claims of U.S. Patent Nos. 6,478,038 and 6,595,227. Claims 24-29 and 31-38 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over the claims of U.S. Patent Application No. 2003/00222484. Upon indication that the Application is otherwise in condition for allowance, Applicants will file a Terminal Disclaimer to overcome the double patenting rejection if still applicable at that time.

The Claims are Patentable over the Kellogg Patent

Claims 25, 26, 29, 36 and 37 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,992,045 to Kellogg et al. (“the Kellogg patent”). Independent claims 25, 29 and 37 each recite a tension member that is configured such that the frame is in a *curved configuration*, and an extension member configured to maintain an *orientation* of the apparatus.

The Kellogg patent discloses a frame having a mesh web stretched over the frame and a strap having free ends that can be coupled together such that the frame can be moved to a particular shape.

The Examiner states that the Kellogg patent includes “a tension member and an extension member (inclusive of members 50 and 60).” Members 50 and 60 of the device of the Kellogg patent cannot each be considered simultaneously a tension member and an extension member. Neither member 50 or 60 alone can provide any tension whatsoever. At most, the Kellogg patent discloses straps 50 and fasteners 60, which when attached together apply tension to the frame. Moreover, the Kellogg patent fails to disclose or suggest “an extension member coupled to at least one of the tension member and the membrane and configured to maintain *an orientation of the sunshade, when the frame member is in the curved configuration*” as recited in

independent claim 25.” The distinction between the tension member that is “dimensioned such that the frame member is in the *curved configuration*” and the extension member that is “configured to maintain an *orientation* of the sunshade, *when the frame member is in the curved configuration*” should not be overlooked. Both the Kellogg patent and the Office Action are silent with respect to such a distinction. Neither the straps 50 or the fasteners 60 of the Kellogg patent have any effect on the *orientation* of the device of the Kellogg patent. For at least these reasons, independent claim 25 is allowable.

Likewise, the Kellogg patent fails to disclose “a tension member coupled proximate to the first end and the second end of the membrane, the tension member being configured to position the frame member in the *curved configuration*” and “an extension member coupled to at least one of the tension member and the membrane and configured to maintain an *orientation* of the apparatus, *when the frame member is in the curved configuration*” as recited in claim 29. For at least this reason, independent claim 29 is allowable.

With respect to claim 37, the Kellogg patent fails to disclose “a tension member coupled to the membrane, a plurality of coupling mechanisms including a first coupling mechanism and a second coupling mechanism; coupling the first coupling mechanism to a remaining coupling mechanism from the plurality of coupling mechanisms; coupling the second coupling mechanism to a remaining coupling mechanism from the plurality of coupling mechanisms, the coupling of the first coupling mechanism and the second coupling mechanism to remaining coupling mechanisms *urging the sunshade into a curved configuration*; and coupling an extension member to the tension member and the membrane, the extension member configured to maintain an *orientation* of the sunshade” as recited in independent claim 37. Both the Kellogg patent and the Office Action are silent with respect to a device that has four separate components (i.e., a

tension member, a first coupling mechanism, a second coupling mechanism *and* an extension member). Moreover, the Office Action fails to account for the distinction between the configuration of the sunshade maintained by the tension member and coupling mechanisms, and the orientation of the sunshade maintained by the extension member. For at least these reasons, independent claim 37 is allowable. Based at least on their dependence upon independent claim 25, dependent claim 26 is also allowable. Claim 36 is allowable at least because of its dependence upon independent claim 32, which is allowable for the reasons discussed below.

The Claims are Patentable over the Wang Patent

Claim 25 stands rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,632,318 to Wang ("the Wang patent"). The Wang patent discloses a sun shield for covering multiple windows of an automobile. The Wang patent includes a pair of flexible frames 20 disposed next to each other in a central panel and two side panels extending from the central panel. The Examiner states that "the frame member can be viewed as curved" because "the frame is in a circular configuration" and because "when lying on a windshield of a car, it is in a (slightly) curved configuration since the windshield (of most vehicles) is also in a slightly curved shape." The Wang patent, however, fails to disclose or suggest "a tension member coupled to the membrane, the tension member being dimensioned such that the frame member is in the curved configuration" as recited in independent claim 25. The fact that the frame of the device of the Wang patent is in a circular configuration is of no significance and is entirely unrelated to any "tension member." The Wang patent fails to disclose or suggest a tension member coupled to the membrane as recited in claim 25. The Examiner's own statement that the panel is curved "when lying on a windshield of a car" emphasizes the lack of any tension member disclosed or

suggested in the Wang patent. For at least these reasons, independent claim 25 is allowable over the Wang patent.

The Claims are Patentable over the Kellogg Patent in view of the Wang Patent

Claim 24 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the Kellogg patent in view of the Wang patent. Both the Kellogg patent and the Wang patent, either alone or in combination, fail to disclose “a first frame[,] a second frame, the second frame being collapsible; and a covering coupled to the second frame, the second frame and the covering together formable as an enclosure . . .” as recited in independent claim 24. For at least this reason, independent claim 24 is allowable over the Kellogg patent and the Wang patent, either alone or in combination. The Examiner suggests that the arguments set forth in the Reply to the prior Office Action with respect to claim 24 are “a moot point” as being directed to new matter. As discussed above, no new matter was presented in the Reply to the prior Office Action. Accordingly, Applicants respectfully request that the Examiner reconsider the Applicants’ remarks and withdraw the rejection of claim 24.

The Claims are Patentable over the Kellogg Patent in view of the Paroussiadis Patent

Claims 27, 28, 31-36 and 38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the Kellogg Patent in view of European Patent No. 202,862 to Paroussiadis (“the Paroussiadis patent”).

Dependent Claims 27, 28, 31 and 38

Dependent claims 27, 28, 31 and 38 are allowable at least because of their dependence upon independent claims 25, 29 or 37, which are allowable over the Kellogg patent for the reasons discussed above.

Independent Claim 32 and its Dependent Claims

The Kellogg patent and the Paroussiadis patent fail to disclose or suggest, either alone or in combination “a tension member coupled proximate to the first end and the second end of the membrane such that the frame member is maintained in the first shape . . . and an extension member coupled to at least one of the tension member and the membrane and configured to maintain an orientation of the apparatus” as recited in independent claim 32. As discussed above, the Kellogg patent and the Office Action fail to distinguish between “a tension member coupled proximate to the first end and the second end of the membrane *such that the frame member is maintained in the first shape*” and the extension member that is “configured to maintain an *orientation* of the sunshade, *when the frame member is in the curved configuration.*” For at least this reason, independent claim 32 is allowable over the Kellogg patent and the Paroussiadis patent, either alone or in combination. Based at least on their dependence upon independent claim 32, dependent claims 33-36 are also allowable.

Conclusion

All rejections have been addressed. Applicants believe that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,

~~COOLEY-GODWARD LLP~~

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